

Remarks/Arguments

A. Status of the Claims

Claims 19-22, 25-28, 30-34, 36, 37, 39-43, and 47 were pending at the time of the action, with claims 23-24 and 44 having been previously withdrawn. Claims 19 and 47 have been amended and claim 48 has been added. Support for these amendments is found throughout the specification and the original claims, for example at page 6, lines 19-20. No claims have been cancelled. Therefore, claims 19-22, 25-28, 30-34, 36-37, 39-43, 47, and 48 are pending and presented herein for reconsideration.

B. The Claim Rejection Under 35 U.S.C. § 103 Has Been Overcome

Claims 19-22, 25-28, 30-34, 36, 37, 39-43, and 47 are rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Conte in view of Spector. Applicant respectfully disagrees.

None of the cited references, alone or in combination, teach or suggests an optical lens having a “peelable film electrostatically adhering to [the] outermost layer of the temporary protective coating, wherein the peelable film ... has been applied by depositing a preformed film onto the temporary protective coating” as currently recited in claims 19 and 47.

As acknowledged by the Action, Conte does not teach coating the protective layer with a peelable film, and thus cannot teach a peelable film electrostatically adhered to a temporary coating, where the peelable film has been applied by depositing a preformed film onto the temporary protective coating. Similarly, Spector describes the formation of a polymeric (peelable and removable protective film (col. 8, line 14) at the surface of a lens wafer, starting from a liquid film forming composition. The film is generally made of PVC/vinyl polyacetate copolymer, and it can be formed on every surface of the lens (col. 7, lines 62-63). Thus, Spector

also does not teach or suggest a film electrostatically adhering to the surface of the lens. Furthermore, Spector does not teach or suggest a “peelable film [which] has been applied by depositing a preformed film onto the temporary protective coating” as recited in claims 19 and 47. Rather, the film is formed by depositing and curing a **liquid** composition directly on the surface of the lens. Adhesion of such a film to the lens surface is due to the fact that the film forming composition is cured in contact with the lens surface, which results in an adhesion that is distinct from that formed by depositing a preformed film. Therefore, the combination of Conte and Spector fails to disclose or suggest at least Applicant’s claimed aspect of having a “peelable film electrostatically adhering to [the] outermost layer of the temporary protective coating, wherein the peelable film ... has been applied by depositing a preformed film onto the temporary protective coating”

Furthermore, contrary to the assertions in the Action, there was no reasonable expectation of success that the combination of these references would be successful. Conte’s temporary coating weakly adheres to the underlying hydrophobic and/or oleophobic surface coating due to the surface properties of said surface coating. It is well-known in the art that it is difficult to make a layer adhere to a hydrophobic and/or oleophobic surface coating. This explains why the temporary protective coating in Conte can be easily removed from such a hydrophobic/oleophobic surface. In light of at least these well-known scientific facts, if a film such as that disclosed in Spector were to be applied to a temporary coating such as that disclosed in Conte, the skilled person would expect that Conte’s temporary coating would be peeled off by being stuck or altered upon removal of Spector’s cured film forming composition.

What is surprising however, is Applicant's discovery that an electrostatic peelable film can be applied to the claimed temporary coating and can be removed therefrom without altering the effectiveness of the temporary coating. In this regard, Applicant's specification teaches:

Surprisingly, it has been found that such protective films can be removed from the lens surface without altering the temporary protective coating despite the high sensitivity thereof to alterations through friction and through contact....

Specification at page 8, lines 31-34. Applicant's surprising technical achievement can be attributed to the use of a film that is electrostatically adhered to the temporary protective layer, "wherein the peelable film ... has been applied by depositing a preformed film onto the temporary protective coating."

Applicant's specification further explains that the degradation of the temporary protective coating is to be avoided when removing the peelable film for technical reasons, as such degradation would cause the temporary coating to lose its ability to ensure sufficient contact between the lens surface and holding pad, which would result in an ineffective trimming of the lens. Specification at page 2, lines 30-35. By comparison, if Conte's temporary protective coating is removed when Spector's film is peeled away (which a person skilled in the art would expect given that the film is cured directly on the surface of the lens, as discussed in detail above), then Conte's temporary coating would lose its ability to provide the necessary adhesion between said coating and a holding pad during trimming. This results in an ineffective edging of Conte's lens. Thus, if Conte and Spector were combined in a manner suggested in the Action, the end result would be destruction of the intended purpose of Conte's temporary coating. Obviousness cannot be established where the proposed modification destroys the functionality of the prior art composition or makes it unsatisfactory for its intended purpose. *See In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); MPEP § 2143.01.

Therefore, Spector and Conte cannot be properly combined as asserted in the Action, as a person skilled in the art would not expect that the use of Spector's film on Conte's coating would work to both protect Conte's coating and, once the Spector film is removed, allow Conte's coating to serve its purpose of ensuring sufficient adhesion between the lens and holding pad during trimming. Rather, it is likely that a person having ordinary skill in the ophthalmic field would be discouraged from following the path set out by the Examiner and would avoid using the Spector film with Conte's trimming process. Obviousness also cannot be established where the reference teaches away from the modification or combination. *See In re Grasselli*, 713 F.2d 731, 743, (Fed. Cir. 1983); MPEP 2145.

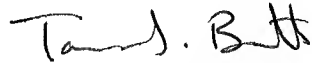
In other words, there was no reasonable expectation of success that the combination of Conte and Spector would work, which is necessary to maintain the obviousness rejection. *See* MPEP § 2143.02 (I) ("The prior art can be modified or combined to reject claims as *prima facie* obvious **as long as there is a reasonable expectation of success.**") (emphasis added).

Based at least on the above, the cited combination of references do not render the current claims obvious and the rejection should be withdrawn.

C. Conclusion

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512.536.3123 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



Tamsen L. Barrett
Reg. No. 57,318
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.
98 San Jacinto Boulevard, Suite 1100
Austin, TX 78701-4255
512.536.3123 (voice)
512.536.4598 (fax)

Date: November 23, 2011